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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ELMORE, R

ART UNIT.

PAPER NUMBER

2786

DATE MAILED:

03/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/020699

Applicant(s)

LEE

Examiner

R. ELMORE

Group Art Unit

2764

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12/21/99
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-2 and 4-19 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-2 and 4-19 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Part III DETAILED ACTION

1. The allowability of the claimed subject matter in claim 17 is *withdrawn*.

Drawings

2. Figures **1 and 2** should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. This figure(s) is described in the background of the specification and in the brief description of the drawings section this figure(s) is not described as being 'according to the present invention'. This figure(s) appears to be "Prior Art" and must be labeled as such to clearly indicate applicant's invention. See MPEP § 608.02(g).

None of the figures are designated as showing an embodiment of the present invention.

This designation would not overcome the objection to figures 1 and 2.

Correction is required.

Specification

3. The objection relating to claim 2 for lacking antecedent basis within the specification is *maintained*. Applicant has not addressed this objection within the response.
4. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112, 1st

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 17 states “comprising the step of evaluating whether lack of agreement results from a keying error, or from guessing”, nothing in the specification indicates as to how the apparatus used or the method or process is able to evaluate the motivation of the card user. How does the system, apparatus or method, determine the difference between a keying error and guessing? Additionally, this limitation cannot be used to predicate patentability since there is nothing claimed as to how the system or method is to react or manage such a step of evaluating result, this constitutes insignificant post solution activity.

Claim Rejections - 35 USC § 102

7. The rejection under ***35 USC § 102(b)*** of claims 1, 4-10, 12-14 and 16 as being anticipated by Suzuki is ***withdrawn*** due to the amendment.

Claim Rejections - 35 USC § 103

8. The rejection of claims 11 and 16 as being unpatentable over Suzuki and Granzow et al. is ***withdrawn*** due to the amendment.

9. The rejection of claim 15 as being unpatentable over Suzuki, Granzow et al. and Chapin, Jr. is *withdrawn* due to the amendment.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-2, 3-10-14, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki**.

Suzuki teaches the claimed invention (claims **1, 6, 14 and 17-19**) substantially as claimed including **a method of determining validity of a transaction carried out by a user at a data processing system, the method including the steps of:**

a. Receiving a user identification card and a first entry of data from the user is taught as scanning the card and entering the PIN (e.g., see col. 1, lines 30-39 and Figure 3); and,

b. Checking the first entry of data against a first stored field of security data is taught as determining the validity of the entered PIN (e.g., see Figure 3);

Suzuki teaches the above listed details of the claims **1, 6, 14 and 17-19**, however, **Suzuki** does not teach **a request for a subset of a second set of identification data and receiving a subset entry from the user**. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to organize the identification data to

use a subset of the identification data because such an organization of the identification data provides additionally security against misuse without incurring significant requirements for either additional hardware or software.

As to claims 2 and 7, Suzuki teaches displaying first and second entries of data after receiving the second entry of data (e.g., see claim 8 of the reference).

As to claim 4, Suzuki teaches one entry of data is the PIN and the other entry of data is data personal to the authorized holder of the card (e.g., see claim 9 of the reference).

As to claims 5 and 12, Suzuki teaches at least one of the first and second stored fields of security data is stored on the user identification card (e.g., see claim 12 of the reference).

As to claims 8 and 13, Suzuki teaches the data processing unit causes the communication means to make at least one further request for data to be entered by the user through the data entry means when an incorrect entry of data is received and then checks the data entered in response to the further request against stored security data (e.g., see Figures 2-5 and col. 4, lines 3-27).

As to claim 9, Suzuki teaches the system responds differently depending on the nature of the error(s) in the data received (e.g., see col. 3-5).

As to claim 10, it is inherent to the system as taught by Suzuki for the insertion of the card by the user to initiate the transaction.

As to claim 16, Suzuki teaches suspending the transaction if there is lack of agreement between the entered data and the stored data (e.g., see Figure 3).

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki in view of Granzow et al.**

Suzuki teaches the independent claim 6 and intervening claims 7-8 as shown above.

As to claim 11, Suzuki does not teach the capture of the user identification card when an error in the data is received in response to a final request, however, Granzow teaches the card is captured if a re-entry of the PIN is still incorrect (e.g., see col. 3, lines 38-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the capture of the card with the invention as taught by Suzuki because this provides additional security and thereby prevents possible misuse of the card.

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Suzuki in view of Chapin, Jr. et al.**

Suzuki teaches the independent claim 14 as shown above.

As to claim 15, Suzuki does not teach the first and second data on the card being encrypted, however, Chapin, Jr. teaches the encryption of data on transaction card (e.g., see the abstract and col. 3, lines 8-30). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the encryption of the data on the card with the invention as taught by Suzuki because this provides additional security and thereby prevents possible misuse of the card.

Art Unit: 2764

Response to Applicant's Remarks

14. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Reba I. Elmore, whose telephone number is (703) 305-9706. The examiner can normally be reached on M-THU from 7:30 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by phone fail, the art unit supervisor, William Grant, can be reached at (703) 308-1108. Additionally, the fax phone for Art Unit 2306 is (703) 308-9051 or 308-9052.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-9600.



Reba I. Elmore
Supervisory Patent Examiner
Art Unit 2700

REBA I. ELMORE
SUPERVISORY PATENT EXAMINER
GROUP 2700